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In re Application of	:	DECISION ON RENEWED
MORDAUNT et al	:	
Int. Application: PCT/US2003/029132	:	REQUEST UNDER
Application No.: 10/531,691	:	
Int. Filing Date: 16 October 2003	:	37 CFR 1.497(d) AND
Priority Date: 17 October 2002	:	
Attorney's Docket No.: P-5458-US	:	PETITION UNDER
For: SYSTEM, MEHOD... WAVELENGTHS	:	37 CFR 1.47(a)

This is in response to the "PETITION TO ADD INVENTOR UNDER 37 CFR 1.48(a)" filed on 04 December 2006, which is being treated as renewed request under 37 CFR 1.497(d) and as petition under 37 CFR 1.47(a).

BACKGROUND

In a decision from this Office mailed on 02 October 2006, the decision indicated that the request was dismissed because the request did not satisfy item (1) of 37 CFR 1.497(d) because the declaration filed was improper.

On 04 December 2006, petitioner submitted a "Petition to Add Inventor Under 37 CFR 1.48(a), which is being treated as a Renewed Request Under 37 CFR 1.47(d) and a Petition Under 37 CFR 1.47(a) requesting the acceptance of the executed declaration without the signature of joint inventor David Mordaunt.

DISCUSSION

REQUEST UNDER 37 CFR 1.47(a):

A submission under 37 CFR 1.497(d) must include:

- (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (2) the fee set forth in § 1.17(I); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR §3.73(b) of this chapter).

A review of the application file reveals that applicants have satisfied items (2) - (3) under 37 CFR 1.497(d), but not item (1).

With respect to item (1), the executed declaration filed on 04 December 2006 is defective and, for the reason below, the application may not enter into national stage processing at this time. It still does not comply with 37 CFR 1.497(a)(3). A Declaration, under 37 CFR 1.497(a)(3), must identify each inventor. See MPEP § 602. In this instance, applicants submitted a composite declaration comprising of three sets of declarations, one which is complete because it has three (3) sheets, and the remaining sets are incomplete. Each set must be complete by having the correct number of pages and listing all the inventors. The other sets are incomplete because pages 1,2 are missing. Therefore the composite Declaration is still incomplete.

Copies of the same page is not part of a proper declaration since it is considered a composite declaration and each must be a complete declaration with the proper statement and the names of each inventor even though each set of declarations may not have all the signatures of the inventors. Therefore, a proper declaration must consist of individual complete sets of declaration that taken as a whole would have all the required signatures as required under 37 CFR 1.497(a)(3).

Accordingly, the request still does not meet the requirements under 37 CFR 1.497(d).

CONCLUSION

For the reasons above, the request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

PETITION UNDER 37 CFR 1.47(a):

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers

should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the **37 CFR 1.47** applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied item (1) of 37 CFR 1.47(a) but not requirements (2) – (4).

Regarding requirement (1), petitioner has provided the petition fee of \$200.00 under 37 CFR 1.17(g) because it has been charged to the Deposit Account No. 50-3355.

Regarding requirement (2), in this case, it has not been sufficiently demonstrated that a copy of the application papers were mailed (or e-mailed) to the non-signing inventor, David Mordaunt, for his review and signature, and that it was received by him.

Regarding requirement (3), petitioner has not provided a statement of the last known address of the missing inventor.

Regarding requirement (4), petitioner has provided a defective composite executed declaration. See above section under 37 CFR 1.497(d).

Consequently, the current record does not sufficiently establish Mr. Mordaunt's refusal to join in the application because no evidentiary documents have been to show that a *bona fide* attempt was made to deliver the complete application to him and that he refused to sign the required papers.

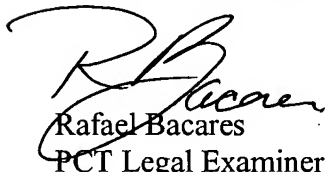
CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

For the reasons above, the request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a) and Renewed Request under 37 CFR 1.497(d)." Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in ABANDONMENT.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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